

Appl. Serial No. 09/966,049
Amendment Dated November 11, 2005
Reply to Office Action of July 25, 2005

31876-0263

Remarks/Arguments

This Amendment is in response to the Office Action mailed July 25, 2005. In this Office Action, the Examiner objected to the abstract because it contained improper language. Additionally, the Examiner rejected claims 2 and 6-9 under 35 USC 112, 2nd paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Further, the Examiner rejected claims 1-14 under 35 USC 102(e) as being anticipated by Weber et al. (US Pat. No. 6,889,180).

1. Objection to the Abstract

The Examiner objected to the Abstract because it contained improper language. Applicant is amending the Abstract to remove the language. Applicant is not adding new matter with this replacement. Applicant therefore requests that the Examiner withdraw the objection to the Abstract.

2. Claim Rejections under 35 USC 112, 2nd Paragraph

The Examiner rejected claims 6-9 under 35 USC 112, 2nd Paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

The Examiner incorrectly analyzed claims 6-9 to conclude that the claims are indefinite under 35 USC 112, 2nd Paragraph. The analysis of Claims 6-9 begins with the understanding they these claims are multiple dependent claims as provided for by 35 USC 112, 5th Paragraph, 37 CFR 1.75(c), and MPEP 608.01(n).

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The 5th paragraph of 35 USC 112 provides the following:

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

37 CFR 1.75(c) provides the following with regard to structure and analysis of dependent claims and multiple dependent claims:

(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. ... Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

And, MPEP 608.01(n) summarizes the above by stating: "generally, a multiple dependent claim is a dependent claim which refers back in the alternative to more than one preceding independent or dependent claim."

Referring back to Claims 6-9 in light of the above, the Examiner will see that the claims are all in a format of "A claim according to claim a, b, c, or d, ...". This format is allowable under the above as each of these claims refers to more than one other claim in the alternative only.

MPEP 608.01(n) and 37 CFR 1.75(c) additionally instructs the Examiner on the proper examination of dependent and multiple dependent claims. The analysis of multiple dependent claims is that a multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered, and by which necessarily includes the statutory type of

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claim. With these guidelines on the analysis of claims, the analysis of claim 6 (as an exemplary claim of the group) is as follows:

Claim 6: A claim according to claim 1, 3, 4, or 5 ...

6/1	(an apparatus claim)
6/3	(a method to make claim)
6/4	(a method to use claim)
6/5	(a program storage device claim)

Since a dependent claim includes all of the limitations of the prior claim and since a multiple dependent claim incorporates all of the limitations of the claims in relation to that which it is being considered, dependent claim 6 will be directed to a single statutory claim during its analysis as applied to each independent claim. Using the above as an example, claim 6/1 is directed to an apparatus claim, claim 6/3 is directed to a method to manufacture claim, claim 6/4 is directed to a method to use claim, claim 6/5 is directed to a program storage device claim. Therefore, claim 6 is directed to a single statutory subject matter during its analysis for each independent claim.

Although not binding on the Examiner, counsel for the Applicant has used this format of multiple dependent claims in the following US patents: 6,745,357; 6,732,346; 6,728,654; 6,714,045; 6,512,333; 6,460,134; 6,457,170; 6,445,213; 6,434,853; 6,370,632; 6,347,327; 6,301,600.

Applicant therefore respectfully requests that the Examiner withdraw the rejections to claims 6-9 under 35 USC 112, 2nd Paragraph.

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3. Claim Rejections under 35 USC 102(e)

The Examiner rejected claims 1-14 under 35 USC 102(e) as being anticipated by Weber et al. (US Pat. No. 6,889,180). After reviewing the Office Action and the Examiner's comments, the Applicant is amending the claims to better clarify the claimed invention.

The Examiner found that Rogers shows and teaches all of the elements and means of the claimed invention. Applicant disagrees with the Examiner and finds that Weber is not a proper 102(e) reference because it does contain all of the elements of Applicant's claimed invention. The Applicant agrees with the Examiner that this application has a common inventor with the Weber reference. And for the Examiner's benefit, the Weber patent and the instant application are owned a common owner, i.e., Intrinsity, Inc. The Applicant notes that the instant application is related to the Weber patent in that it contains similar material. However, the instant application is a novel and non-obvious improvement upon the Weber patent.

Since independent claims 1, 3, 4, and 5 are similar in scope and independent claims 10, 12, 13, and 14 are similar to and narrower than the other claims, the Applicant will discuss the Examiner's rejection of the claims using claim 1 as an exemplary claim. Referring to the Office Action, the Examiner cites Weber column 5, lines 33-41 and column 4, lines 12-31 as showing the following elements from claim 1:

n ordered axis declarations wherein n is at least 1, each said axis declaration names an axis comprising a first axis through a nth axis, wherein each said axis corresponds to a functional attribute of the design and has an axis size that comprises two or more functional states of said functional attribute and has a corresponding axis variable; ...

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The Applicant is unable to find the above claim elements in the cited material in the Weber patent. A discussion of the above claim elements is found in the specification at paragraph 51.

Further, the Examiner cites Weber column 4, lines 12-31 as showing the following elements from claim 1:

one or more logic expressions that evaluate whether the design has achieved one or more of said functional states, said logic expressions set each one of said n axis variables to an integer value corresponding to said functional state when said logic expressions evaluate true; and ...

The Applicant is unable to find the above claim elements in the cited material in the Weber patent. A discussion of the above claim elements is found in the specification at paragraph 53.

Further, the Examiner cites Weber column 5, lines 43-45, column 5, lines 33-41, and column 4, lines 12-31 as showing the following elements from claim 1:

a grid declaration that converts said n axis variables to an integer that is a unique linear index value that corresponds to the cross-product of said functional states achieved by the design, said grid declaration also records a hit at said unique linear index value.

The Applicant is unable to find the above claim elements in the cited material in the Weber patent. A discussion of the above claim elements is found in the specification at paragraphs 51, 52, and 53.

Since the amended claims include elements and limitations that are not shown, taught, or even implied by Weber, Applicant therefore respectfully requests that the Examiner withdraw the claim rejections to claims 1-14 under 35 USC 102(e) as being anticipated by Weber et al. (US Pat. No. 6,889,180).

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4. Summary

In view of the above, Applicant believes that each of the presently pending claims is in immediate condition for allowance or appeal. Accordingly, Applicant respectfully requests that the Examiner withdraw the outstanding objections and rejections of the claims and issue a timely Notice of Allowance in this case.

Respectfully submitted,



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